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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,954	02/27/2002	Dwip N. Banerjee	AUS920020025US1	5351
35525	7590	06/10/2008		
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER KHATTAR, RAJESH	
			ART UNIT 3693	PAPER NUMBER
			NOTIFICATION DATE 06/10/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

Office Action Summary	Application No. 10/087,954	Applicant(s) BANERJEE ET AL.	
	Examiner RAJESH KHATTAR	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of the Appeal Brief Request filed on 3/24/2008, PROSECUTION IS
HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the
following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply
under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed
by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and
appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth
in 37 CFR 41.20 have been increased since they were previously paid, then appellant
must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by
signing below:

Acknowledgements

The examiner for this application has changed. Please indicate Examiner Rajesh Khattar as the examiner of record in all future correspondence. This Office action is in response to Applicant's communication filed on 3/24/2008. Claims 1-41 are pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 (and elsewhere), the use of the term "if" represents alternative language. The use of the term "if" raises an issue that limitation appearing after the phrase "if" may or may not occur. This renders the claim indefinite. Examiner requests the Applicant to positively recite claim limitations.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The active steps cited for claim 1 are purely mental steps and don't tie to another statutory class (such as a particular apparatus).

Claims 25-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The barter protocol language and a computer program are software features that are not a patentable subject matter under the statutory guidelines of 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5, 7, 9, 23-26, 32-33, 36, 38 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheets, US Patent Application No. 2001/0049653 in view of Flickinger et al., US Patent Application No. 2001/0025245 and further in view of Ibuki et al., US Patent Application No. 2003/0041058. Sheets discloses a method for carrying out a bartering system over a network, comprising:

receiving a needs list having at least one needed item a user desires to acquire ([0026]); receiving a priority indication for the at least one needed item ([0026]), wherein the priority indication indicates a level of desire the user has in acquiring the at least one need item ([0026]);

Sheets fails to specifically disclose

wherein the priority indication indicates items that are equivalent to the at least one needed item;

However, Flickinger discloses wherein the priority indication indicates items that are equivalent to the at least one needed item ([0070], [0073], search for comparable items).

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Sheets to include the disclosure of Flickinger. The motivation for combining these references would be to search for comparable or “better” items/prices as illustrated by Flickinger.

Moreover, Sheets and Flickinger do not specifically disclose constructing the needs list with the priority indication into a barter protocol language; and searching available items for a match with each of the at least one needed item based upon the priority indication wherein an item having a lower priority indication is matched as being equivalent to the at least one needed item only if an item having a higher priority is not found.

However, Ibuki discloses these features ([0077], [0079], [0087], claims 11-12, 33-34, 55-56).

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Sheets, Flickinger to include the disclosure of Ibuki. The motivation for combining these references would be to present to the user an alternative value to be specified for an item in order to automatically widen the search criteria as illustrated by Ibuki.

Regarding claim 2, Ibuki discloses the bartering protocol language specifies a range of near equivalency associated with a plurality of dissimilar items to form near

equivalent items, wherein the near equivalent items are items that are dissimilar to the at least one needed item, and wherein the priority indication indicates whether a near equivalent item will be satisfactory to the user in lieu of the at least one needed item ([0079], plurality of similar values represent near equivalent items that are dissimilar to the needed item since the exact match is not found).

Regarding claim 5, Ibuki discloses a range of near equivalent items ([0079], plurality of similar values are found, all of them are presented to the user so that the user can select one from them).

Regarding claim 7, Ibuki discloses the match is a chained association involving the needs list and availability lists of a plurality of users ([0057]-[0063]).

Regarding claim 9, Ibuki discloses a second priority indication for a given available item indicating a user's desire to use the given available item to carry out a bartering transaction ([0079]).

Regarding claim 23, Ibuki discloses indicating equivalency of at least one available item with at least one needed item ([0079]).

Regarding claim 24, Ibuki discloses finding a match for at least one given available item in consideration for a found match for at least one given needed item, wherein the at least one available item, and the at least one needed item are represented in terms of equivalency ([0079]).

Claims 25-26, 32-33, 36, 38 and 40-41 are substantially similar to claims 1-2, 5, 7, 9, 23-24 and hence rejected on similar grounds.

Claims 3, 6, 34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheets in view of Flickinger in view of Ibuki and further in view of Geary, US Patent No. 6,070,160. Sheets, Flickinger and Ibuki disclose their invention as described above.

Regarding claim 3, all fail to specifically disclose searching available items is performed first within a first bartering system and performed second across a different bartering system if no match is found during the search within the first bartering system. However, Geary discloses this feature (col. 2, lines 60-col. 3, lines 3, col. 8, lines 5-15, artist/title database search; col. 14, lines 64-col. 15, lines 11, multiple database search).

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Sheets, Flickinger and Ibuki to include the disclosure of Geary. The motivation for combining these references would be to broaden the scope of the search as illustrated by Geary.

Regarding claim 6, Geary discloses the match is a direct match having a one to one correspondence (col. 8, lines 5-15, col. 18, lines 2-15).

Claims 34 and 37 are substantially similar to claims 3 and 6 and hence rejected on similar grounds.

Claims 4, 8, 35 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheets in view of Flickinger in view of Ibuki in view of Geary and further in view of Lefebvre et al., US Patent Application No. 2002/0091574. Sheets, Flickinger, Ibuki and Geary disclose their invention as described above.

Regarding claim 4, all fail to specifically disclose wherein the first bartering system associated with a first barter protocol language and wherein the different bartering system associated with a second barter protocol language and further comprising translating, before the searching is performed across the different bartering system, the needs list from the first barter protocol language to a common barter protocol language, wherein the common barter protocol language comprises a representation of the needs list and an availability list that is common to both the first bartering system and the different bartering system. However, Lefebvre discloses these features ([0017], [0089], [0160]).

Therefore, it would have been obvious to a person having ordinary skills in the art at the time then invention was made to modify the disclosure of Sheets, Flickinger, Ibuki and Geary to include the disclosure of Lefebvre. The motivation for combining these references would be to translate client application requests into XML requests **802** as illustrated by Lefebvre ([0160]).

Regarding claim 8, Lefebvre discloses the first bartering system associated with a first barter protocol language and wherein the different bartering system associated with a second barter protocol language and further comprising translating, before the searching is performed across the different bartering system, the needs list from the first barter protocol language to the second barter protocol language ([0017], [0089], [0160]).

Claims 35 and 39 are substantially similar to claims 4 and 8 and hence rejected on similar grounds.

Claims 10-22 and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheets in view of Flickinger in view of Ibuki and further in view of Official Notice. Sheets, Flickinger and Ibuki disclose their invention as described above. All fail to specifically disclose the second priority indication is indicated by a monetary value that the user is willing to accept for the given available item, receiving a monetary value associated with each of the at least one needed item, receiving a monetary value priority indication, associated with the received monetary value, wherein the monetary value priority indication indicates a user's willingness to vary a payment value for a given needed item from the monetary value, receiving monetary value associated with each of the at least one available item, receiving monetary value priority indication, associated with the received monetary value, wherein the monetary value priority indication indicates a user's willingness to vary a received value for a given available item from the monetary value, the monetary value is received from data provided by a rating agency, receiving a priority indication for a group of two or more items, the barter protocol language is XML, one needed/available item can be at least one of a physical item and a nonphysical item, each physical and nonphysical item has a corresponding representation mechanism within the barter protocol language, the nonphysical item represents a needed/available service. Examiner takes Official Notice as these limitations e.g. the second priority indication is indicated by a monetary value that the user is willing to accept for the given available item, receiving a monetary value associated with each of the at least one needed item, receiving a monetary value priority indication, associated with the received monetary value, wherein the monetary

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value priority indication indicates a user's willingness to vary a payment value for a given needed item from the monetary value, receiving monetary value associated with each of the at least one available item, receiving monetary value priority indication, associated with the received monetary value, wherein the monetary value priority indication indicates a user's willingness to vary a received value for a given available item from the monetary value, the monetary value is received from data provided by a rating agency, the barter protocol language is one of a markup language e.g. XML, one needed/available item can be at least one of a physical item and a nonphysical item, each physical and nonphysical item has a corresponding representation mechanism within the barter protocol language, the nonphysical item represents a needed/available service are old and well known in the art.

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Sheets, Flickinger and Ibuki to include the limitations that are old and well known as per Official Notice. The motivation for combining these references would have been within the knowledge of a person skilled in the art.

Response to Arguments

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAJESH KHATTAR whose telephone number is (571)272-7981. The examiner can normally be reached on Flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

/R. K./
Examiner, Art Unit 3693